

## **REMARKS**

### **I. Status of the Claims**

Claims 1-51 are pending in this application. Claims 1, 32, 37, 43, 47, and 48 are amended herein to recite that the at least one fluorescent dye is not chosen from azomethine fluorescent dyes. Claims 3, 4, 33, 34, 41, and 42 are amended herein to correct the spelling of "nanometer." Claims 5, 35, and 49 are amended herein to delete the recitation of azomethine fluorescent dyes. Claims 6, 36, and 50 are amended herein to delete the azomethine dye of formula (F2). Support for these amendments can be found in the specification at least on page 6, paragraph [025], which states that "[i]n accordance with another aspect of the present disclosure, the at least one fluorescent dye of the cosmetic composition is not a compound chosen from azo, azomethine, and methine monocationic heterocyclic fluorescent dyes." Applicant further submits that this proviso is fully supported as described below and, therefore, that no new matter has been added by this amendment.

Applicant believes that the proviso added to the claims is fully supported by the specification as filed. Applicant asserts that he is simply claiming less than the full scope of the disclosure – a legitimate procedure for inventors entitled to decide the bounds of protection they seek. See, e.g., *In re Johnson*, 558 F.2d 1008 (C.C.P.A. 1977). The court in *Johnson* found that a "broad and complete generic disclosure, coupled with extensive examples fully supportive of the limited genus now claimed" supported the exclusion of specific compounds. 558 F.2d at 1018. In *Johnson*, a broad class of precursor compounds was recited including 26 specific examples. An added proviso excluded certain compounds to provide a limited genus, where 14 examples fell

within the scope of the limited genus. The court in *Johnson* held that the written description supported the broader genus, and “having described the whole, necessarily described the part remaining.” *Id.* at 1019.

*Ex parte Grasselli*, 231 USPQ 393, 394 (Bd. Pat. App. 1983) is often cited by the USPTO in response to an amendment limiting the scope of a claim in view of prior art. In *Grasselli*, the claim at issue related to a process for the ammoxidation of propane or isobutane comprising using a catalyst described in a certain formula. In response to an Office Action, the Applicant amended a claim to recite that the catalyst was free of uranium and the combination of vanadium and phosphorus. The claimed formula, however, did not originally cover uranium. Thus, the Applicant sought to exclude uranium from the catalyst, but uranium was not a species falling within the genus of the recited catalytic formula. The Board held that there was no written description for the negative limitation.

The *Grasselli* facts sharply contrast with the present facts. In *Grasselli*, uranium was never covered by the original genus. In the present case, Applicant seeks nothing more than to proviso out a particular species of fluorescent dye (azomethine fluorescent dyes), which falls within the original genus of compounds defined. Thus, *Grasselli* is inapplicable to the present application.

Moreover, adequate written description, particularly with respect to provisos, does not require literal support for the claimed invention. *In re Wertheim*, 191 USPQ 90, 98 (CCPA 1976). Applicant asserts that the present facts fall directly within the rationale of *Wertheim*, which held that to rule that the entire genus is not patentable because the applicant erroneously thought he was the first to invent the genus of

compounds would exalt form over substance. *Id.* at 97. The present situation, like that in *Wertheim* (and in contrast to the situation in *Grasselli*), does not involve a new concept. Rather, the present situation involves a member of the originally claimed genus that is simply being excised. *Wertheim* approved that approach, and the Office has no reason to treat Applicant any differently.

As established above, Applicant has the right to claim less than the full scope of their disclosure, and thus can exclude azomethine fluorescent dyes. As such, Applicant asserts that the proposed proviso has sufficient support in the specification.

## **II. Allowable Subject Matter**

Applicant thanks the Examiner for his indication that claims 7 and 8<sup>1</sup> would be allowable if rewritten in independent form. See Office Action at 5 and Office Action Summary. However, Applicant chooses not to amend the claims in this manner at the present time. Applicant believes that, in view of the amendments and arguments made herein, all pending claims 1-51 should now be ready for immediate allowance.

## **III. Rejections Under 35 U.S.C. § 103**

Claims 1-6, 9-20, and 22-51 are rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Application Publication No. 2001/0054206 to Matsunaga et al. ("Matsunaga") in view of U.S. Patent Application Publication No. 2002/0046431 to Laurent et al. ("Laurent"). Claim 21 was rejected under 35 U.S.C. § 103(a) as being

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<sup>1</sup> In the text of the Office Action, the Examiner indicated claims 6 and 7 were allowable; however, the Office Summary indicates that claims 7 and 8 are objected to. Applicant believes the Examiner meant to refer to claims 7 and 8 in the text of the Office Action. Please correct this assumption if it is incorrect.

unpatentable over *Matsunaga* in view of *Laurent* and further in view of U.S. Patent No. 5,744,127 to Guiseppe et al. ("Guiseppe"). Applicant asserts that these rejections are obviated in view of the claims as amended.

To prove a *prima facie* case of obviousness, the Examiner must show that the cited references would have provided to the skilled artisan some suggestion or motivation to combine or modify their teachings in an effort to achieve all of the limitations of the claimed invention, with a reasonable expectation of success. See MPEP § 2143. For at least the reasons discussed below, none of the references relied upon by the Examiner contain any such suggestion or motivation or the requisite reasonable expectation of success.

The present claims, for example, independent claims 1, 32, 37, 43, 47, and 48 as amended, recite at least a composition comprising, in a cosmetically acceptable medium, at least one fluorescent dye that is soluble in the medium and at least one cationic polymer with a charge density of at least 1 meq/g, wherein the at least one fluorescent dye is not chosen from azomethine fluorescent dyes.

In contrast, *Matsunaga* describes hair dye compositions containing an azomethine dye as direct dye. See abstract. *Matsunaga* suggests that the hair dye composition may further comprise cationic polymers. See page 3, paragraph [0024]. *Matsunaga* does not disclose or suggest hair dye compositions comprising fluorescent dyes other than the particular described azomethine dyes. Thus, *Matsunaga* fails to teach or suggest a composition comprising at least one fluorescent dye with at least one cationic polymer wherein the at least one fluorescent dye is not chosen from

azomethine fluorescent dyes. To the contrary, azomethine dyes are a required part of *Matsunaga's* invention.

*Matsunaga* is the sole reference relied upon by the Examiner which allegedly discloses fluorescent dyes in hair dye compositions. None of the secondary references (*Laurent* and *Guiseppe*) disclose or suggest hair dye compositions comprising fluorescent dyes. Thus, any combination of these references also necessarily fails to teach or suggest a composition comprising at least one fluorescent dye with at least one cationic polymer wherein the at least one fluorescent dye is not chosen from azomethine fluorescent dyes. Accordingly, in view of the above arguments and claim amendments, Applicant asserts that the presently pending claims are patentably distinct over the prior art and respectfully request that the Examiner withdraw all rejections and allow the claims.

### **CONCLUSION**

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: \_\_\_\_\_  
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